

REMARKS

This Amendment is responsive to the Office Action mailed September 23, 2008. By this Amendment, Applicants amend claims 1, 12, 16, 24, 35, and 42. Claims 2-11, 13-15, 17-23, 25-34, 36, 37, 39-41, 44-47, 49-50, 52, and 54-56 remain canceled. Accordingly, claims 1, 12, 16, 24, 35, 38, 42, 43, 48, 51, and 53 are pending and claims 1, 12, 16, 24, 35, 42, 43, 48, 51, and 53 are under consideration. Claim 38 is withdrawn. Applicants note that the specification fully supports the amendments to the claims. For example, pages 4 – 26 of the specification provide support for the amendment regarding the moieties of formula (I) and (IA). Furthermore, support for the amendments as filed can be found in the specification and claims as filed, e.g., original claims 1 and 24.

Reconsideration and withdrawal of the rejections made in the above-referenced Office Action are respectfully requested in view of the foregoing amendment and the following remarks.

Telephonic Interview with the Examiner

Applicants thank the Examiner for a telephonic Interview on October 23, 2008 with Applicants' representative. During the phone conversation, Applicants representative discussed with the Examiner the propriety of the obviousness-type double patenting rejection. Applicants note that the cited document, namely U.S. application no. 11/252,232, published as U.S. Patent Application Publication No. 2006/0100161 A1 to Hans et al. is improper for a double patenting rejection because Hans et al. has no common inventor or assignee with the present application. Applicants note that the Examiner conceded this finding and stated that the double patenting rejection was made in error.

Furthermore, Applicants representative discussed with the Examiner the origin of the structure depicted in paragraph 5, at page 2 of the Office Action, which the Action asserts to be grounds for presenting a structure falling into the non-elected subject matter. The Examiner explained that this structure is presented in the Hans application. In response, Applicants further note that Hans et al. fails to qualify as prior art and therefore cannot be asserted in a restriction requirement. Applicants will discuss this point in further detail below.

Information Disclosure Statement

Applicants thank the Examiner for acknowledgement of receipt of the Information Disclosure Statement filed August 26, and for consideration of the majority of documents listed therein by returning signed and initialed copies of the forms PTO-1449. As, for the documents not considered by the Examiner, the Action states that these documents were missing and therefore not considered.

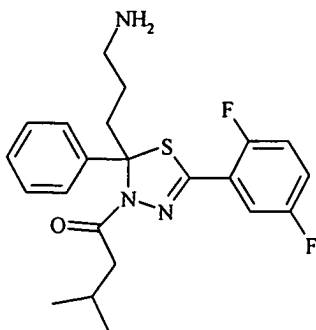
Upon review of the application on the Patent Application Information Retrieval website (PAIR), Applicants note that the allegedly missing documents are retrievable on PAIR and therefore should have been considered. Applicants note that the scans of the allegedly missing documents were combined with preceding documents and therefore only retrievable when opening and fully reviewing the preceding document. Accordingly, Applicants respectfully submit that error in combining separate documents lies with Office.

However, Applicants note that a Supplemental Information Disclosure Statement is submitted with this response to direct the Examiner's attention to documents identified in the family member application of a copending and commonly assigned U.S. Application. Therefore, in order to assure that the Examiner can properly consider all of the documents on the record, Applicants resubmit the allegedly missing documents.

Response to previous Amendment

Applicants note with appreciation that the previous rejection under 35 U.S.C. § 112, first paragraph and the objection of claim 42 have been withdrawn.

The Action maintains the objection to claims 1, 16, 24, 38, 42, 43, 48, 51, and 53 for containing non-elected subject matter. In support for the objection, the Action relies on the following compound



which is disclosed in Hans et al. at page 66 and falls into the scope of the non-elected subject matter.

In response, Applicants respectfully submit that the earliest possible effective filing date of Hans et al. is October 19, 2004 (the date of filing of the provisional application to which Hans et al. claims priority), which is after the effective filing date of the present application of October 8, 2004. Therefore, Applicants respectfully submit that Hans et al. cannot be considered as art and thus cannot form the basis for a lack of unity restriction. Accordingly, Applicants are under no obligation to amend the claims to the elected subject matter. Applicants respectfully request withdrawal of this objection.

Furthermore, in view of the foregoing, Applicants respectfully request prompt consideration and examination of the non-elected subject matter.

Claim Rejections under 35 U.S.C. § 112, second paragraph

The Action rejects claim 24 under 35 U.S.C. § 112, second paragraph for allegedly being indefinite with respect to the term “as that mentioned above.” With the foregoing amendment, Applicants address this rejection and respectfully request its withdrawal.

Double Patenting

The Office rejects claims 24, 35, 43, 48, and 51 provisionally on the ground of non-statutory obviousness-type double patenting in view of U.S. Application No. 11/252,232 to Hans

et al. In view of the fact that Hans et al. has no common inventor or assignee, Applicants respectfully request withdrawal of the double patenting rejection.


Conclusion

In view of the foregoing, the Examiner is respectfully requested to reconsider and withdraw the objection and rejection of record, and allow all the pending claims.

No additional fee is believed due at this time. If, however, any additional fee is necessary to ensure consideration of the submitted materials, the Patent and Trademark Office is hereby authorized to charge the same to Deposit Account No. 19-0089.

Should there be any questions, the Examiner is invited to contact the undersigned at the below listed telephone number.

Respectfully submitted,
Chikara MURAKATA et al.



Bruce H. Bernstein
Reg. No. 29,027 42,920

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GREENBLUM & BERNSTEIN, P.L.C.
1950 Roland Clarke Place
Reston, VA 20191
(703) 716-1191